

The Examiner objects to the expression "acid-containing solution additive" and construes the expression as meaning an acid-containing solution also containing an additive in view of Claim 3. Applicants have eliminated any reference to "an acid containing solution" in the claims. The language of Claim 3 has been amended to include both a plasticizer and a diluent. (See Claim 3 as originally filed.)

Applicants have amended Claim 1 in a good faith effort to eliminate language from Claim 1 which is not accurate and to eliminate compositions from the claims which are duplicative of the prior art cited. Applicants have canceled Claim 7, *et al.* as the scope and content of the invention is now covered in Claim 1.

Applicants respectfully submit that the amendment to Claim 1 and cancellation of Claim 7 and other amendments to the claims dependent thereon removes the rejections cited by the Examiner pursuant to 35 U.S.C. §112, first paragraph and second paragraph. If the Examiner believes that further amendments are necessary, Applicants will be pleased to comply with his suggestions.

The Examiner is requested to reconsider his rejection of Claims 1, 3, 7, 14 -16, 20, 22, 23, 25 and 40 – 42 under 35 U.S.C. §103(a) as obvious over Elsenbaumer (US 4,983,322) alone or in view of Havinga et al. (US 5,908,583).

Elsenbaumer discloses a solution comprising polyaniline, a solvent, and a dopant solute. Applicants do not claim any of the various compositions disclosed in Elsenbaumer, and Claim 1, in view of the transitional phrase used therein, cannot be construed as reading on Elsenbaumer or Havinga, et al.

The basis for Applicants' assertion stated above as to the construction of the scope of coverage provided in the pending claims in the instant application, is found in MPEP Section 2111.03 (Transitional Phrases) which provides:

"The transitional phrase 'consisting of' excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ('consisting of' defined as 'closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.' "). Emphasis added.

Claim 1 contains the operative word "consisting of," so the compositions and steps are limited to those elements specifically claimed.

Applicants are aware that if constituents are present in a blend, the purpose for the presence of the constituent is immaterial. The case law provides that the composition (blend), etc., inherently possesses all beneficial properties asserted to be associated with the constituent(s). But for Elsenbaumer (alone) to be anticipatory, it must possess the polymers, the specific additive plasticizers and specific solvents now recited in Claim 1 of the present invention.

A comparison of the individual composition elements of Claim 1 with the Elsenbaumer disclosure clearly confirms that none of the composition elements of Elsenbaumer are found in the composition elements defined in Applicants' Claim 1.

First, with respect to the solvents used in the two systems, Applicants' "solvent" as now defined in Claim 1 is "n-cyclohexylpyrrolidinone, dimethylenepropylene urea and N,N dimethyl propylene urea." The Elsenbaumer solvent is listed in the reference as comprising the following:

"alkyl alkanesulfonates such as methyl methanesulfonate, ethyl methanesulfonate, butyl methanesulfonate, propyl ethanesulfonate;  
nitriles such as acetonitrile, propionitrile, butyronitrile, benzonitrile and the like;  
aromatic solvents such as nitrobenzene and the like;  
carbonates such as propylene carbonate, dimethyl carbonate, ethylene carbonate and the like;  
nitroalkanes, such as nitromethane, nitroethane, nitropropane, and the like;  
amides such as dimethyl formamide, dimethyl thioformamide, N,N-dimethyl acetamide, N-methylpyrrolidinone and the like;  
organophosphorus compounds such as hexamethyl phosphoroamide, diethylphosphate, triethylphosphites, trimethylphosphate and the like; and  
organosulfur compounds such as sulfolane, methyl sulfolane, dimethyl sulfone, dimethyl sulfoxide, glycol sulfite, tetraethylsulfamide and the like.  
Mixtures of such organic solvents can also be used, as for example mixtures of sulfolane and acetonitrile."

None of Applicants' solvents as claimed is found in the list of solvents disclosed by Elsenbaumer.

Second, Applicants' "plasticizer additive" as now defined in Claim 1 is "selected from the group consisting of: poly-co-dimethyl aminopropyl siloxane, polyglycol diacid, 3,6,9 trioxaundecanoic acid, polyethylene glycol tetrahydro furfuryl ether, glycerol triacetate and epoxidized soy bean oil."

Elsenbaumer makes no disclosure of any specific plasticizer additive that functions for the purposes disclosed by Applicants. Elsenbaumer is silent as to the use of such an additive.

Third, Applicants' "dopant" as now defined in Claim 1 is "citric acid and acrylamidopropanesulfonic acid."

The Elsenbaumer dopants are disclosed at Column 6, line 51 through 7, line 22, which states:

"The second essential ingredient of the solution or plasticized composition of this invention is an 'oxidizing dopant.'... Illustrative of useful dopants are AsF<sub>5</sub>, MoOCl<sub>4</sub>, MoCl<sub>5</sub>, PCl<sub>5</sub>, POCl<sub>3</sub>, PCl<sub>3</sub>, AlCl<sub>3</sub>, NO<sup>+</sup> and NO<sub>2</sub><sup>+</sup> salts (such as NOBF<sub>4</sub>, NOBF<sub>6</sub>, NOSbF<sub>6</sub>, NOAsF<sub>6</sub>, NOCH<sub>3</sub> CO<sub>2</sub>, NO<sub>2</sub> BF<sub>4</sub>, NO<sub>2</sub>PF<sub>6</sub>, NO<sub>2</sub>AsF<sub>6</sub>, NO<sub>2</sub>SbF<sub>6</sub>, and NO<sub>2</sub>CF<sub>3</sub>SO<sub>3</sub>), HClO<sub>4</sub>, HNO<sub>3</sub>, H<sub>2</sub>SO<sub>4</sub>, p-toluenesulfonic acid (TsOH), benzoylperoxide, CF<sub>3</sub>SO<sub>3</sub>H, SO<sub>3</sub>, Br<sub>2</sub>, (FSO<sub>3</sub>)<sub>2</sub>, ZnCl<sub>2</sub>, FSO<sub>3</sub>H, Fe(III) salts (such as Fe(BF<sub>4</sub>)<sub>3</sub>, FeBr<sub>3</sub>, Fe(CH<sub>3</sub>SO<sub>3</sub>)<sub>3</sub>, Fe(CIO<sub>4</sub>)<sub>3</sub>, FeCl<sub>3</sub>, Fe(OTS)<sub>3</sub>, and Fe(CF<sub>3</sub>SO<sub>3</sub>)<sub>3</sub> which give rise to doped polymers containing dopant solutes such as NO<sub>3</sub><sup>-</sup>, CH<sub>3</sub>SO<sub>3</sub><sup>-</sup>, AlCl<sub>4</sub><sup>-</sup>, BF<sub>4</sub><sup>-</sup>, ZnCl<sub>4</sub><sup>-</sup>, PCl<sub>4</sub><sup>-</sup>, PF<sub>6</sub><sup>-</sup>, AsF<sub>6</sub><sup>-</sup>, SbF<sub>6</sub><sup>-</sup>, CF<sub>3</sub>SO<sub>3</sub>, ClO<sub>4</sub>, OTs, SO<sub>3</sub>, C<sub>6</sub>H<sub>5</sub>CO<sub>2</sub> CH<sub>3</sub>SO<sub>3</sub>, FSO<sub>3</sub>, and FeCl<sub>4</sub><sup>-</sup>. Other useful electron acceptor dopants include electrolyte salts such as LiClO<sub>4</sub>, LiBF<sub>4</sub>, LiAsF<sub>6</sub>, Bu<sub>4</sub>NClO<sub>4</sub>, Bu<sub>4</sub>NOTs, Bu<sub>4</sub>NCF<sub>3</sub> SO<sub>3</sub>.sub.3, LiCF<sub>3</sub> SO<sub>3</sub>, AgOTs, and the like. Preferred for use in the practice of this invention are oxidizing dopants selected from the group consisting of MoOCl<sub>4</sub>, MoCl<sub>5</sub>, PCl<sub>5</sub>, POCl<sub>3</sub>, and Fe (III) salts such as Fe(CIO<sub>4</sub>)<sub>3</sub>, FeCl<sub>3</sub>, FeBr<sub>3</sub>, and Fe(CF<sub>3</sub>SO<sub>3</sub>)<sub>3</sub>, and particularly preferred for use in the practice of this invention are dopants selected from the group consisting of MoOCl<sub>4</sub>, MoCl<sub>5</sub>, PCl<sub>5</sub>, POCl<sub>3</sub>, FeBr<sub>3</sub> and FeCl<sub>3</sub>. Amongst these particularly preferred embodiments, most preferred are those embodiments in which the oxidizing dopant is FeCl<sub>3</sub>.

This disclosure by Elsenbaumer of his dopants and preferred dopants does not disclose the dopants claimed by Applicants in Claim 1.

The Havinga et al. reference is cited by the Examiner solely because: "The instant dopant such as camphorsulfonic acid is well known in the art..." In order to assess the legal propriety of such a combination, a review of the total teaching found in the Havinga et al. reference is warranted.

Havinga et al. state that their invention relates to "a semiconducting polymer comprising a conjugated repeating unit." The invention is directed to a "genus," namely a "semiconducting polymer." As such, there are potentially hundreds or thousands of species of semiconducting polymers that fall within the scope of the genus. Havinga et al. mention a publication by Cao et. al. in *Synth. Met.*, 48 (1992), page 91, wherein a description is given of a semiconducting polymer called "polyaniline (PANI)." Havinga et al. then proceed to state in the patent reference that in general, the processability of the polyaniline is adversely affected by the presence of large conjugated chains. By way of illustration, Havinga et al. note that processing, from solution, of the undoped electrically insulating form of polyaniline, i.e. the emeraldine base-form, requires the use of N-methylpyrrolidone, an amine or a strong acid, such as concentrated sulfuric acid, as the solvent. These solvents are unattractive for use on an industrial scale. Also the limited choice of solvents forms an impediment to an extensive application of these polymers.

Havinga et al. conclude that within the art there is a need for semiconducting polymers which, despite the presence of a large conjugated system, exhibit a satisfactory solubility in customary organic solvents and, after doping, a satisfactory conductivity. The unequivocal conclusion reached by a skilled artisan based upon these statements by Havinga, et al. is that polyaniline is not a satisfactory semiconducting polymer for the desired objectives expressed by Havinga et al.

Havinga et al.'s objective is achieved, not by the use of polyaniline (of the type disclosed by Elsenbaumer and Cao), but by a polymer of the type having a repeating unit chosen in accordance with the formula  $(-A-NH-B-S-)$ , wherein A and B are equal or different conjugated groups (moieties). It has been found that the sulfur atoms and the nitrogen

atoms, which are alternately present in the conjugated chain, give rise to a good solubility in customary organic solvents in the absence of substituents linked to the conjugated chain. Both the sulfur atom and the nitrogen atom contain a lone pair which forms part of the conjugated system, thereby forming a continuous, conjugated chain, so that a good electric conductivity is attained after doping.

In principle, the choice of the conjugated groups A and B is free, provided that they are not so large that the solubility-increasing effect of the alternating sulfur atoms and nitrogen atoms is annihilated. A group A or B is too large if, taken as a separate molecule, it cannot be dissolved in the solvent in which solubility of the corresponding polymer is desired.

Havinga et al also disclose a method of preparing their semiconducting polymer, the structure of which is noted above. In the method a sulfoxide monomer in accordance with the formula  $\text{H}-\text{A}-\text{NH}-\text{B}-\text{SO}-\text{CH}_3$ , wherein A is equal to an 1,4-phenylene and B is the same or a different conjugated unit, is dissolved in a strong acid, thereby forming a sulphonium polymer having the repeating unit  $(-\text{A}-\text{NH}-\text{B}-\text{S}^+(\text{CH}_3)-)$ , which is subsequently brought into contact with a demethylation agent, thereby forming the polymer having the repeating unit  $(-\text{A}-\text{NH}-\text{B}-\text{S}-)$ . In view of the suitable choice of the starting compound  $\text{H}-\text{A}-\text{NH}-\text{B}-\text{SO}-\text{CH}_3$ , a polymer is formed in which the sulfur atoms and the nitrogen atoms are alternately present in the chain. None of this chemistry is applicable to the polyaniline of Elsenbaumer.

In their reference, Havinga et al. then distinguish their polymer from the polyaniline of Elsenbaumer and Cao by stating at Column 3, line 16:

"Unlike, for example, polyaniline obtained by oxidation of aniline, the conjugated chain is substantially free of topologic defects, and network-formation does not take place, which has a favorable effect on the solubility of the polymer and on the reproducibility of the preparation. For example, the viscosity of a polymer solution is governed substantially by the degree of network-formation."

There is no proper basis to combine the Havinga et al. reference with Elsenbaumer as they each are directed to totally different polymers. The polymers have different

properties and will interact differently with other compositions. There is no basis to accurately predict how selected compositions effective in one system will behave in the other system. It is the objective of Havinga, et al. to teach away from the polyaniline of Elsenbaumer for the reasons stated. Because Havinga et al. and Elsenbaumer disclose totally different composition blend systems, it is improper to arbitrarily select a specific element from Havinga et al. and combine it with the polyaniline system of Elsenbaumer. The skilled artisan recognizes that the whole teaching of both of these references must be considered, and having done so, the skilled artisan will recognize that there is no proper basis to assume that despite the fact the polymers are totally different, the other constituents parts are interchangeable to achieve useful results.

The Examiner is requested to reconsider his rejection of Claims 1, 3, 6, 7, 14 -16, 20, 22, 25 and 40 - 42 under 35 U.S.C. §103(a) as obvious over Elsenbaumer (US 4,983,322) alone or in view of Havenga et al. (US 5,908,583), and further in view of Cao et al. (US 5,232,631).

The description of the Elsenbaumer and Havenga et al. references articulated above is hereby incorporated by reference herein for the purpose of responding to the obviousness rejection cited above.

Cao discloses conductive polymers, and the use of functionalized protonic acids in a solvent to induce processibility of electrically conductive substituted or unsubstituted polyanilines.

In further support that the obviousness rejection based upon Elsenbaumer and Havenga et al. references in view of Cao is improper, Example 4 of the Cao reference discloses that not all solvents act effectively as polyaniline solvents. Cao discloses that with respect to a polyaniline-DBSA blend, toluene, 1,2,4-trichlorobenzene, chloroform, decalin and xylenes are effective solvents, whereas dimethylsulfoxide, dimethylacetamide, dimethylformamide and formic acid do not act as solvents.

Applicants' claims now specifically recite the presence of specific polymers, specific plasticizer additives and specific solvents, wherein the "*said solvent being different from said additive.*" Cao discloses (unlike Elsenbaumer with his dimethyl acetamide, dimethyl formamide and dimethyl sulfoxide) that as "solvents" those compositions are not effective.

Cao, at Column 16, line 49 to Column 17, line 39 discloses specific problems that may arise as a result of attempting to form an oriented film. Thus without more detailed information as to how to rectify the problems stated in Cao as to film processing, the skilled artisan would not use the Cao reference in combination with Elsenbaumer and Havinga et al. serving as the primary reference to render the instant invention obvious.

The composition elements now defined in Applicants' Claim 1 are not found in the Elsenbaumer, Havinga et al. and Cao references

There is no basis to combine Cao with the Elsenbaumer and Havinga et al. references. Applicants respectfully submit that with the amendments made to Claim 1, none of the elements of independent Claim 1, such as those mentioned above are present in the asserted combination of references cited by the Examiner in this case. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The failure of an asserted combination to teach or suggest each and every feature (element) of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103(a).

Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render the claims unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents to the Elsenbaumer and Havinga et al. references and Cao must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (Thus the case law uniformly holds

that to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art).

As the Board of Patent Appeal and Interferences has confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features (elements) is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Applicants submit that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention *as described and claimed*.” (emphasis added).

Lastly, Applicants respectfully direct attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features (elements) of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

It remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. *See In re Wada and Murphy*, *citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

In rejecting claims under 35 USC 103(a) the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker* 977 F.2d 1443, 1445 (Fed. Cir. 1992). *Se also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine* 837 F.2d 1071, 1073 (Fed. Cir. 1988). In doing so, the



Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), and in addition, provide some "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006, cited with approval in *KSR Int'l Co. v. Teleflex Inc.* 127 S.Ct 1727, 1741 (2007). Only if this initial burden is met, does the burden of coming forward with evidence or argument shift to Applicant. (*Oetiker*, 977 F.2d. at 145, and *Piasecki*, 745 F.2d at 1472.

The dependent claims are nonobvious under section 103 if the independent claim(s) from which they depend are nonobvious. *In re Fine* 837 F.2d 1071, 5 USPQ 2d 1596, (CAFC 1988) citing *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed.Cir.1987); *In re Abele*, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); see also *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983).

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103 is warranted. Applicants submit that the Examiner has applied the *Elsenbaumer*, *Havinga et al.* and *Cao* references discussed above using a selective combination to render obvious the instant invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in *Uniroyal* found that a combination of various features from a plurality of prior art references suggested the claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or

suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing *Lindemann*, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

The Examiner has described what the Elsenbaumer, Havinga et al. and Cao references teach, but has not stated what each does not teach alone or in combination. The Examiner has selected elements from the Elsenbaumer, Havinga et al. and Cao references for the sake of showing the individual elements without regard to the total teaching of the references. There is no suggestion that elements in Elsenbaumer are missing that would optionally make the invention more effective or efficient, or that the system disclosed therein needs to be improved upon, or could optionally be improved upon by adding some additional elements. The skilled artisan reading Elsenbaumer and then Havinga et al. would recognize the substantial difference between the polymers disclosed in each reference, and would not combine the two based upon the lack of teaching in Elsenbaumer to suggest such combination. Elsenbaumer's disclosure is complete on its face. The same argument and rationale applies with respect to the use of Cao with the references to Elsenbaumer and Havinga et al.

Thus the Examiner in his application of the Elsenbaumer, Havinga et al. and Cao references is improperly picking and choosing. The rejection is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) *In re Wesslau* 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the Elsenbaumer,

Havinga et al. and Cao references to support the rejections and did not cover completely in the Office Action the full scope of what these references teach and/or fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so. There is no suggestion in the Elsenbaumer, Havinga et al. and Cao references that they could or should be combined.

It is respectfully submitted that the Examiner has not provided any "suggestion" from the cited art to modify the Elsenbaumer and Elsenbaumer and Havinga et al. references. The Examiner has merely used hindsight as noted *supra*. Also there nothing in said prior art that would lead one of ordinary skill in the art to modify the existing art in the manner claimed by Applicants. Further as required by *In re Kahn* (*supra*) no "articulated reasoning with some rational underpinning to support the legal conclusion of 'obviousness' is provided to support the suggested modifications." As such, it is respectfully submitted a *prima facie* case for obviousness has not been made with respect to any of the claims. As all objections are believed obviated with this amendment, favorable action is respectfully requested.

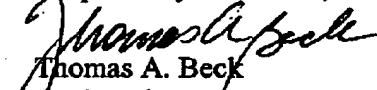
Applicants summarize one of their positions with respect to the Examiner's rejections in this case by referring to the decision of the CAFC in *In re David H. Fine*, 837 F.2d 1071, 5 USPQ 2d 1596, (CAFC 1988), which held in pertinent part:

"...Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And 'teachings of references can be combined only if there is some suggestion or incentive to do so.' *Id.* Here, the prior art contains none.

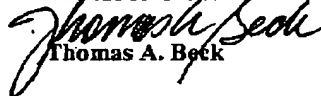
Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore*, 721 F.2d at 1553, 220 USPQ at 312-13. It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention..."

In view of the arguments and modifications to the claims, allowance of this case is warranted. If the Examiner wishes to discuss via telephone the substance of any of the proposed claim changes contained herein with the intent of putting them into an allowable form, Applicants' attorney will be glad to speak with him at a mutually agreeable time and will cooperate in any way possible.

Respectfully submitted,

  
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I hereby certify that this resubmitted amendment response is being telefaxed to (571) 273-8300 on the date indicated below addressed to Commissioner of Patents & Trademarks, Post Office Box 1450, Alexandria, VA 22313-1450.

  
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